

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Customer Number: 46320
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Virinder BATRA, et al.	:	Confirmation Number: 6050
	:	
Application No.: 10/068,362	:	Group Art Unit: 2152
	:	
Filed: February 6, 2002	:	Examiner: A. Wildhalm
	:	
For:		OBTAINING LOCATION INFORMATION USING A REJECTION MODEL

Mail Stop AF
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR PRE-APPEAL BRIEF REVIEW

Sir:

Applicants request that a Panel Review of the twice-rejected claims in the Office Action dated May 1, 2006, be performed in the above identified application.

CLAIMS 1-12 ARE REJECTED UNDER THE SECOND PARAGRAPH OF 35 U.S.C. § 112

On page two of the second Office Action dated May 1, 2006 (hereinafter the second Office Action), the Examiner rejected the claims "as being incomplete for omitting essential elements," after failing to reject the identically presented claims on this basis in the first Office Action. In support of this rejection the Examiner cited M.P.E.P. § 2172.01.

At the outset, Applicants note that the case law referred to in M.P.E.P. § 2172.01 generally applies to "kit" or "assembly" claims. Independent claims 1 and 7, however, are

respectively directed to a method and a machine readable storage, which on their face do not appear to be kit or assembly claims.

Moreover, as summarized in M.P.E.P. § 2172.01, the case law requires that the alleged omitted essential matter be identified by Applicants as "essential" within the "specification" or within "other statements of record." The Examiner, however, has failed to establish the features alleged by the Examiner to be omitted, have been identified, by Applicants, as being essential.

Applicants surmise that the Examiner has misinterpreted the enablement requirement of the first paragraph of 35 U.S.C. § 112, since the Examiner appears to be requiring that the claims enable the invention. This requirement, however, is not consonant with the first paragraph of 35 U.S.C. § 112, which requires only that the specification describe how to make and use the invention. Therefore, Applicants respectfully submit that the Examiner has failed to establish a proper rejection under the second paragraph of 35 U.S.C. § 112.

CLAIMS 1-12 ARE REJECTED UNDER THE SECOND PARAGRAPH OF 35 U.S.C. § 112

On page three of the second Office Action, the Examiner rejected the claims as being indefinite after again failing to reject the identically presented claims on this basis in the first Office Action.

Similar to the prior rejection, the Examiner appears to be requiring the claims enable the invention. The Examiner has asserted, for several claimed limitations, that "there are many devices at which these functions may be performed." The Examiner appears to be concerned that the claimed language is so broad as to cover several different devices. However, breadth should not be confused with indefiniteness.¹ Moreover, Applicants have determined that a specific device does not have to be associated with the specifically claimed method steps to

¹ In re Miller, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971); M.P.E.P. § 2173.04.

"particularly point out and distinctly claim the subject matter" that Applicants regard as the currently presented invention.

Applicants' position is that one having ordinary skill in the art would have no difficulty understanding the scope of claims 1-12, particularly when reasonably interpreted in light of the written description of the specification.² Therefore, Applicants respectfully submit that the Examiner has failed to establish a proper rejection under the second paragraph of 35 U.S.C. § 112.

CLAIMS 1-4 AND 7-10 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON KIMOTO ET AL., U.S. PATENT NO. 6,829,484 (HEREINAFTER KIMOTO), IN VIEW OF LIMING, U.S. PATENT PUBLICATION NO. 2002/0055924

Independent claims 1 and 7 both recite "receiving a rejection response to said forwarded network request and identifying in said rejection response a request for required location information." On page 6 of the second Office Action, the Examiner cited Kimoto as disclosing this entire limitation while specifically asserting:

receiving a rejection response to said forwarded network request (see figure 18 #S8, figure 46 #D3, *negative outcome is a rejection response*) and identifying in said rejection response a request for required location information (see figure 46 #D5, *selection offered to user is a request for required location information*). (emphasis in original)

Notwithstanding that the Examiner has failed to establish that the combination of Kimoto and Liming teach or suggest other limitations recited in the claims and failed to establish a proper factually-supported motivation to combine, on the basis of the above-identified limitation alone, the Examiner has failed to establish a prima facie case of obviousness.

The Examiner separately refers to Figs. 18 and 46 to teach the above-identified limitation, but these separate figures (and teachings) referred to by the Examiner are completely

² In re Okuzawa, 537 F.2d 545, 190 USPQ 464 (CCPA 1976); In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

unrelated. Applicants do not disagree that S8 (i.e., an "ERROR MESSAGE") disclosed in Fig. 18 could be construed as teaching a rejection response. However, nowhere does Kimoto teach or suggest that the error message, S8, in Fig. 18 includes "a request for required location information," as recited. Thus, the error message, S8, in Fig. 18 does not correspond to the claimed rejection response.

The Examiner also referred to D3 in Fig. 46 as teaching "receiving a rejection response to said forwarded network request." However, even a cursory review of Fig. 46 yields the conclusion that D3 does not teach "a rejection response." Instead, D3 refers to a decision block in a method, which is labeled "HAS THE INFORMATION BEEN REGISTERED?" Moreover, the Examiner's asserted "rejection response" (i.e., D3) is not in response to a forwarded network request for location-based processing. Instead, column 50, lines 20-25 of Kimoto clearly states that step D3 is to determine "whether data (the identification information and the position information) transmitted from the mobile terminal 4 is already registered in the corresponds database 55 or not," which is not location-based processing.

With regard to step D5 (i.e., the Examiner's asserted "identifying in said rejection response a request for required location information"), Kimoto only states with regard to D5 that "the information center 5 transmits proposed landmarks corresponding to the received position information to the mobile terminal 5 having transmitted the position information (Step D5)" (column 50, lines 29-32). Kimoto fails to teach or suggest that "a request for required location information" is identified in a rejection response. Therefore, for the reasons stated above, Kimoto fails to disclose the above-identified limitation for which Kimoto is being relied upon; and thus, the Examiner has failed to establish a prima facie case obviousness.

**CLAIMS 5-6 AND 11-12 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED
UPON KIMOTO IN VIEW OF LIMING AND HIMMEL ET AL., U.S. PATENT NO. 6,167,441**

Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 1 and 7 under 35 U.S.C. § 103 for obviousness based upon Kimoto in view of Liming. The Examiner's analysis regarding the combination of Kimoto, Liming, and Himmel does not cure the argued deficiencies of the Examiner's analysis regarding the combination of Liming and Himmel. Applicants, therefore, respectfully submit that the imposed rejection of claims 5-6 and 11-12 under 35 U.S.C. § 103 for obviousness based upon Kimoto in view of Liming and Himmel is not viable.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: August 1, 2006

Respectfully submitted,

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CUSTOMER NUMBER 46320